

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 11-22, 24 and 29-37 are presently active in this case. Claims 23 and 25-28 have been cancelled without prejudice or disclaimer. The present Amendment amends Claims 11, 13-18, 21-22 and 24; and adds new Claims 29-37 without introducing any new matter.

In the outstanding Office Action, Claims 11, 13, 17 and 20-28 were rejected under 35 U.S.C. §103(a) as unpatentable over Bauer, II (U.S. Patent No. 3,692,394, herein “Bauer”) in view of Ohshima et al. (U.S. Patent No. 4,821,911, herein “Ohshima”) and further in view of Hines (U.S. Patent No. 6,122,455); Claims 12 and 14-15 were rejected under 35 U.S.C. §103(a) as unpatentable over Bauer in view of Ohshima and Hines and further in view of Glenn (U.S. Patent No. 4,667,226); Claims 16 and 18-19 were rejected under 35 U.S.C. §103(a) as unpatentable over Bauer in view of Ohshima and Hines and further in view of Okada et al. (U.S. Patent No. 4,758,905, herein “Okada”).

To vary the scope of protection recited in the claims, new Claims 29-37 are added. New independent Claim 35 is presented for examination, reciting similar features as independent Claim 11, and further recites a focal plane adapter, but does not recite the spectral splitter and the at least two rotative elements of the shutter.¹ New dependent Claims 29-31 depend upon Claims 11, 22 and 24 and recite a feature regarding the off-field view image.² New dependent Claims 32-34 and 36 depend upon Claims 11, 22, 24, and 35 respectively and recite features regarding the lengths of the optical paths.³ New dependent Claim 37 depends upon Claim 35 and recited features regarding rotative elements of the

¹ Finds non-limiting support in the disclosure as originally filed, for example from page 2, line 4 to page 3, line 13 and in corresponding Figure 1

² Idem at page 3, lines 9-13.

³ Idem in Figure 1.

shutter.⁴ Since new Claims 29-37 find non-limiting support in the disclosure as originally filed, they are not believed to raise a question of new matter.⁵

To clarify Applicant's invention, independent Claims 11, 22 and 24 are amended. Applicant therefore respectfully submits that the outstanding rejections of Claims 11-28 under 35 U.S.C. §103(a) are rendered moot in light of these amendments.

In particular, independent Claim 11 is amended to recite "a shutter configured ... to direct the light to the viewfinder along a viewfinder optical axis... without further change of the viewfinder optical axis." This feature finds non-limiting support in the disclosure as originally filed, for example at page 3, lines 4-6 and in corresponding Figure 1. Independent Claims 22 and 24 are amended to recite similar features.

Applicant respectfully submits that all the references used by the outstanding Office Action to form the 35 U.S.C. §103(a) rejections, fail to teach or suggest a shutter configured to direct the light to the viewfinder along a viewfinder optical axis, without further change of the viewfinder optical axis, as next discussed.

The reference Bauer, used by the outstanding Office Action as a primary reference to form the 35 U.S.C. §103(a) rejections, describes a motion picture camera, where the images are reflected by the forward surface 22 to the reflecting prism 24 and a lens system 26 to an eyepiece 28. Accordingly, and as illustrated in Bauer's Figure 1, the optical path is reflected twice by the rotary reflective shutter 16 and the prism 24 to get to the eyepiece 28. Therefore, Bauer fails to teach or suggest a shutter configured to direct the light to the viewfinder without further change of a viewfinder optical axis. Furthermore, Bauer is also silent regarding the features of Applicant's dependent Claim 32, regarding the lengths of the optical paths. Bauer's optical path from the camera lens 14 to the motion picture film 20 is

⁴ Idem at page 7, lines 1-14 and in corresponding Figure 3.

⁵ See MPEP 2163.06 stating that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter."

significantly shorter than the optical path from the camera lens 14 to the reflecting prism 24 or the lens system 26 of the eyepiece.⁶ Accordingly, Bauer also fails to teach or suggest an optical path from the objective support to the optical viewfinder is shorter than an optical path from the objective support to the spectral splitter, as recited in dependent Claim 32.

The remaining applied references Ohshima, Hines, Glenn and Okada also fail to teach or suggest Applicant's feature regarding a shutter configured to direct the light to the viewfinder without further change of a viewfinder optical axis. While Ohshima and Glenn do not disclose viewfinders, Hines' viewfinder is arranged separate from the main optical axis and Okada's system includes an electronic viewfinder 61 that gets the image from the image sensor 23.⁷ Accordingly, the remaining references, taken individually or in combination, also fail to teach or suggest all the features of Applicant's claims and therefore Applicant traverses the rejection of independent Claim 11 and request reconsideration of the rejection.

Since independent Claims 22 and 24 recite analogous features in the context of a means-plus-function claim (Claim 22) and a method claim (Claim 24), the rejection of independent Claims 22 and 24 under 35 U.S.C. §103(a) is also believed to be overcome.

Regarding Applicant's dependent claims, since the independent Claims 11, 22 and 24 are believed to be allowable, the dependent Claims are also believed to be allowable.

Further, Applicant further respectfully traverses the obviousness-type rejection of Claims 20-21 based in the Official notices.⁸ Since M.P.E.P. §2141.02 requires that the invention as a whole be considered and the Official Notices taken in the outstanding Office Action were applied in the context of a 35 U.S.C. §103 rejection, Applicant submits that the present amendment in effect traverses the Official Notices in the outstanding Office Action. Regardless of whether or not the features noticed in the outstanding Office Actions are well

⁶ See Bauer in Figure 1 and from column 1, line 58 to column 2, line 10.

⁷ See Hines in Figure 12 and 13.

⁸ See the outstanding Office Action from page 4, line 21 to page 5, line 13.

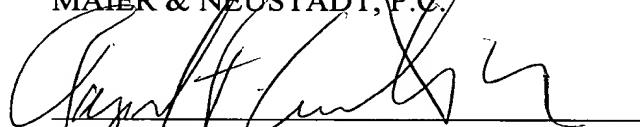
known, M.P.E.P. §2144.03 states that it is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record, as the principal evidence upon which a rejection is based. Accordingly, Applicant traverses the 35 U.S.C. §103 rejections based on the numerous Official Notices taken in the outstanding Office Action for the reason that, without the temporal and structural context by which these features are known to the artisan, it is impossible to conclude that it would be obvious for one of ordinary skill in the art at the time of the invention to combine those noticed features with the art of record. Indeed, the context by which these features are allegedly known might itself provide reasons to rebut a *prima facie* case of obviousness.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 11-17, 19-22, 24 and 29-37 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599

Raymond F. Cardillo, Jr.
Registration No. 40,440

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)